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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/609,622 07/05/00 SUNVOLD

G IAM 0602 PA

EXAMINER

HM22/1018
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COE, S

ART UNIT

PAPER NUMBER

1651

DATE MAILED:

10/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action	Application No. 09/609,622	Applicant(s) SUNVOLD ET AL.	
	Examiner Susan Coe	Art Unit 1651	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 October 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 10 October 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached "Supplement to Advisory Action".
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-9 and 14.

Claim(s) withdrawn from consideration: 10-13.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9.
10. ☐ Other:

SUPPLEMENT TO ADVISORY ACTION

1. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.

2. The information disclosure statement filed October 10, 2001 fails to comply with 37 CFR 1.97(d) because it lacks a petition requesting consideration of the information disclosure statement. It has been placed in the application file, but the information referred to therein has not been considered.

3. All of applicant's arguments regarding the 102 rejection of record have been fully considered but are not persuasive. Applicant argues that US Pat. No. 5,104,677 does not anticipate claims 1 and 8 because US '677 does not teach using a low glycemic index grain to promote weight loss. Applicant states that the corn starch used in Table II is not a low glycemic index grain. However, US '677 teaches that corn ^{bran}~~bran~~ can be used in the composition. Applicant argues that US '677 teaches adding corn bran as fiber rather than a carbohydrate source. Regardless of the purpose for adding the grain source, US '677 still teaches a composition that contains all of applicant's claimed ingredients. Therefore, US '677 is still considered to anticipate the claims.

4. All of applicant's arguments regarding the 103 rejection of record have been fully considered but are not persuasive. Applicant argues that there is no motivation without hindsight reasoning to combine the references because the Purina Product Guide does not specifically teach that Vitamin A is a required ingredient in the weight loss composition and because US Pat.

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No. 5,240,962 does not teach using corn, sorghum, wheat, and barley as a low glycemic index grain carbohydrate source in a weight loss composition. However, the Purina Product Guide clearly teaches a dry food that contains corn and Vitamin A. The purpose of this food is to lower weight. In addition, US '962 teaches that corn, sorghum, wheat, and barley are suitable carbohydrate sources for use in a weight loss composition (see column 5, lines 30-35). A person of ordinary skill in the art would reasonably expect that the carbohydrate sources used in US '962 could be used as the carbohydrate source in the Purina dry food based on the teaching by US '962 that these carbohydrates are useful in weight loss foods.

Regarding applicant's argument that US '962 does not teach that the carbohydrates are useful because they are low glycemic index grains, as stated above, there is considered to be sufficient motivation to add the carbohydrates to the composition taught by Purina. Therefore, using these carbohydrates in a weight loss composition flows from the teaching of the prior art. Simply because applicant has a different reason for adding the carbohydrates cannot be the basis for patentability.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). All of the ingredients in applicant's composition were known in

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the art at the time of the invention to be useful in weight loss compositions. Therefore, the combination of the ingredients is not based on hindsight reasoning.


5. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SDC
October 17, 2001



FRANCISCO PRATS
PRIMARY EXAMINER